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In re Application of
Liberale, et al.
Application No. 10/586,205
Filed/Deposited: 13 July, 2006
Attorney Docket No. CCV/Dresser 030957 US
(CM)

OFFICE OF PETITIONS

DECISION

This is a decision on the petition filed on 3 June, 2010, supplemented on 29 June, 2010, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

**As to the Request to Withdraw
the Holding of Abandonment**

Petitioners always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness and showing requirements for relief under 37 C.F.R. §1.181.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 31 October, 2008, with reply due absent extension of time on or before 31 January, 2009.

The application went abandoned by operation of law after midnight 31 January, 2009.

The Office mailed the Notice of Abandonment on 6 August, 2009.

On 4 September, 2009, Petitioner filed a petition pursuant to 37 C.F.R. §1.181—however, rather than make the documentary showings (docket sheet/file jacket cover and due date calendar for the firm) Petitioner instead made some of the statements required but failed to satisfy the document requirements/showing as set forth in the guidance in the Commentary at MPEP 711.03(c)(I). (Again, Petitioner failed to include a due date calendar and the docket sheet/file jacket of the application, and chose instead simply to state that the Office action was returned to the Office undelivered.) The petition was dismissed on 28 September, 2009, and Petitioner had two (2) months to reply.

On 26 January, 2010, with a request and fee for extension of time Petitioner re-advanced the petition, again providing some of the required statements/documentation, but not all, and stated that “Cameron does not maintain a master docket for all prosecution matters, but rather Cameron maintains an individual docket for each application.” The guidance in the Commentary at MPEP 711.03(c)(I) requires and Petitioner was requested to present not a “master docket for all prosecution matters,” but rather the docket for the individual application (which Petitioner submitted) and what is in essence a copy of the firm’s due date calendar for the reply due date (here: 31 January, 2009)—the latter of which it appeared Petitioner did not present. As stated in the MPEP and set forth below: “[the] report showing all replies docketed for a date three months from the mail date of the nonreceived Office action[,]” and this latter document Petitioner did not provide. Alternatively, also as set forth below, the MPEP requires: “If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.” The petition was dismissed on 8 March, 2010.

On 3 June, 2010, with a request and fee for extension of time Petitioner re-advanced the petition, again providing a docket sheet for the application and another document identified preliminarily as an “Attorney Docket Report” and appearing to cover from 1 January, 2009 (“1JAN2009”) through 1 February, 2009 (“1FE2009”), and appearing to be the due date calendar for Petitioner’s and/or Petitioner’s client’s office. However, the materials were not explicit in this regard. The submission was explicit as to the other statements, primarily provided by Manish B. Vyas (Reg. No. 54,516) (Mr. Vyas), averred to be the Managing Attorney, Patent Services of Petitioner’s client Cameron International Corporation. Petitioner’s further statements/showings as to non-receipt at the address of record, search and non-discovery, description of mail/Office action docketing system and its suitable reliability were provided. Mr. Vyas indicates at paragraph 10 of his statement (pages 3-4) that the document identified as the “Attorney Docket Report” and appearing to cover from 1 January, 2009 (“1JAN2009”) through 1 February, 2009 (“1FE2009”), was a due date calendar of his firm/office for calendaring of this matter.

Petitioner further supplemented the record on 29 June, 2010, indicating that the document identified as the “Attorney Docket Report” and appearing to cover from 1 January, 2009 (“1JAN2009”) through 1 February, 2009 (“1FE2009”), indeed was the due date calendar Petitioner’s client’s firm/office for calendaring of this matter.

Thus, Petitioner sought to comply with and satisfy the showing pursuant to 37 C.F.R. §1.181 consistent with the guidance in the Commentary at MPEP 711.03(c)(I), which provides in pertinent part:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.¹

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and those registered to practice and all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

¹ *See*: MPEP §711.03(c)(I)(A).

² *See* supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. *See Changes to Patent Practice and Procedure*, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.³ ⁴,

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁵

³ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

⁵ In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how and when it is to be made and supported.

Petitioner appears to have made the showing required.

CONCLUSION

Accordingly, the petition as considered under 37 C.F.R. §1.181 is granted, and the 6 August, 2009, Notice of Abandonment hereby is vacated.

The instant application is released to Technology Center/AU 3753 for further processing in due course, to include the re-mailing of the non-final Office action previously mailed on 31 October, 2008, but not received.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁶) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁶ The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.